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EXAMINER

FISCHMANN, BRYAN R

ART UNIT	PAPER NUMBER
3618	

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/059,973

Applicant(s)

HONG, SHI-CHAO

Examiner

Bryan Fischmann

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 is/are rejected.
- 7) ☒ Claim(s) 1, 3 and 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### ***Acknowledgments***

1. The Substitute Specification (paper 9) and Amendment (paper 10) filed 9-13-2003 have been entered.

### ***Specification***

2. The abstract of the disclosure (as amended by paper 7) is objected to because of the following:

A) To be grammatically correct, the word "is" on line 8 should instead be the word "are".

3. The disclosure (as amended by paper 9) is objected to because of the following:

A) Page 1 recites "Skating is an exercise consuming a large amount of heat".

This recitation is objected to, as being awkward.

Suggested improved wording is "Skating is an activity requiring a large output of energy", or similar.

B) Page 1 recites "One of prior art states has...". This recitation is objected to, as being awkwardly worded.

Suggested improved wording is "A known prior art skate has", or similar wording.

C) To improve wording, it is recommended that the word "upon" be added after the word "improved" at the end of paragraph "2" on page 1.

D) To improve wording, it is recommended that the phrase "...the buckle has an engaging teeth which protrudes downwards and extends inwards so that the engaging teeth is exactly engaged to the tooth bank..." on the last lines of page 1 be reworded

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"the buckle has engaging teeth which protrude downwards and extend inwards so that the engaging teeth are exactly engaged to the tooth bank...".

E) Since Figures 3A and 3B appear to be "front views", it is believed that they are properly described as "front views", as opposed to "plane views", as they are described on page 2 in the Brief Description of the Drawings" section.

F) Similarly, it is believed that the word "plane" should not be present in the description of Figure 4.

G) The recitation of "the user may wear the shoes which is then buckled to the skate A", that appears in the lower portion of page 2 is believed better worded "the user may wear shoes which are then buckled to the skate A".

H) To improve wording, it is believed that the word "tighten" in the first line of the last paragraph of page 2 should instead be "fastened".

I) To be grammatically correct, the word "coupling" should instead be "coupled" in the last line of page 2.

J) To improve wording, the recitation of "The inner end of the buckle 32 has an engaging teeth 322 which protrudes downwards and extends inwards" in the middle of page 3 is believed better worded "The inner end of the buckle 32 has engaging teeth 322 which protrude downward and extend inwards".

K) To improve wording, the recitation of "for adjusting the size of skate A properly" on page 4 is believed better worded "for properly adjusting the size of skate A".

***Drawing Objections***

4. Figure 3-A of the formal drawings submitted 03-23-03 is objected to, as it is not clear why reference number 33 is enclosed within parenthesis.

***Claim Objections***

5. Claims 1 and 4, as amended by paper 10 are objected to because of the following:

A) To be grammatically correct, the word "is" should appear before the word "integrally" on line 6 of claim 1.

B) To be clear that "a user" is not being positively recited in claim 1, which is not allowed per 35 USC 101, it is recommended that the first line of the last paragraph of claim 1 be modified to read "wherein the buckle is capable of being pressed by a user...".

C) To be properly worded, the recitation of "distal" in claim 4 should be followed by the word "end".

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant regards as his invention.

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A) The claim 2 recitation of "...a periphery of the lower cover is installed with a buckling disk; thereby, the lower cover is tightly coupled to a lower end of the front seat by buckling..." is considered unclear due to the following:

As best understood, the "lower cover" is reference number 31. The Examiner cannot find a reference number that corresponds to the term "buckling disk. Due to this, it is unclear what structure is being claimed by this term.

Also, it is not clear what is meant by the recitation of "the lower cover is tightly coupled to a lower end of the front seat by buckling" in claim 2. As best understood, the lower cover is "coupled" to the front seat by attachment to the buckle 32 by reference number 313. The lower cover does not appear to be "buckled" to the front seat. Note that the term "buckle" refers to a type of fastener where two loose ends are attached by a catch, such as a belt buckle. The lower cover would appear to be "attached" to the front seat, as opposed to being "buckled" to the front seat.

Note that Section 608.01 (o) and 2173.05(a) of the MPEP requires that nomenclature used in the claims be apparent from the specification, unless it is apparent from the prior art.

Note that Section 608.01(g) of the MPEP also recites "The description is a dictionary for the claims and should provide clear antecedent basis for all terms used in the claims".

### ***Allowable Subject Matter***

8. Claims 1, 3 and 4 would be allowable if the claim objections were overcome.

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9. Claim 2 would be allowable if the 112 2<sup>nd</sup> rejection were overcome.

***Response to Applicant's Remarks (paper 10) and Examiner's Comments***

10. The substitute specification (paper 9) and amendment (paper 10) resolved all specification and claim objections made on the last Office Action. Unfortunately, upon further review, additional problems were noted, as set forth in this Office Action (paper 11).

11. The Examiner did not understand the Applicant's comment in paper 10 that "the IDS has been deleted". The IDS (paper 7) was just modified by the Examiner to refer to US Patent 6,547,261 instead of the corresponding application 09/737,955, as was listed on the IDS.

12. Additionally, since the Applicant is located overseas, the Applicant may want to consider giving the Examiner authority to make minor changes to the Application, in the event any other minor wording problems were overlooked by the Examiner, so that additional correspondence is not required. Also recommend that the Applicant thoroughly review the Application for any wording problems that may have been overlooked by the Examiner.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
**BRYAN FISCHMANN**  
**PATENT EXAMINER**